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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/514,946
Filing Date: February 28, 2000
Appellant(s): FERNANDES, RICHARD

Vincent M. DeLuca
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/17/04.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) **Grouping of Claims**

Appellant's brief includes a statement that claims 3, 4, 10, 24 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) **Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) **Prior Art of Record**

6,055,573	GARDENSWARTZ ET AL	4-2000
6,285,987	ROTH ET AL	9-2001

(10) **Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-10 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al in view of Roth et al (US6285987).

Gardenswartz et al discloses prior art systems that provide targeted banner ads to Internet web site visitors. Gardenswartz et al discloses Internet-connected users that collect cookies stored on their machines as they visit different web sites. When the user accesses a particular web site, a cookie (including userID) is uploaded to the web server [col 2 lines 11-19] so as to request customization of the web page. This uploading/reading inherently includes at least temporary storage of the cookie's

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information (sites visited, userID, activity) and is taken to provide consumer information storage. Because cookies are used to track online activity, the web server can deliver a targeted advertisement based on the users online activity. [col 2 lines 20-23]. "The web server can deliver ad banners to the consumer's web browser based on the IP addresses the web browser has accessed... Thus, the cookie can be used to record the online activity of a consumer" [col 2 lines 24-28]. The user's tastes and tendencies can be inferred from the activity and this can be used as a basis for the selection of the targeted ad [col 2 lines 28-33]. The stored preferences information can be taken to be the sites visited (user prefers those sites). Further, the inferred preferences [col 2 lines 28-33] used to target an ad inherently requires at least temporary storage of such preference information to carry out such targeting by the computer system described by Gardenswartz et al. Further, Gardenswartz et al suggests relying on Internet activity *including online purchases* as a basis for targeted advertising. Such purchases can also be taken to be "consumer preference information" contained in said activity information.

Roth et al teaches a central server that is used to carry out targeted Internet advertising at various websites. Roth et al teaches tracking user's visits to particular web sites [col 1 lines 30-38] and using this information to provide targeted ads. The centralized system includes database storage of ads as well as storage of information regarding the subscribing sites [col 2 lines 1-5]. Depending on the customer visiting, the characteristics of the subscribing site and other information, an ad is selected to be displayed to the user [col 2 lines 20-41]. It would have been obvious to one of ordinary

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skill at the time of the invention to have implemented a centralized system as described by Roth et al so that targeted ads can be selectively sent to web site viewers of various/plural subscribing member web sites.

Regarding claim 1, it is inherent that the promotions of Gardenswartz et al and/or Roth et al are promoting either goods or services. Cookies are taught to be used to track sites visited (IP addresses) as well as online purchases, as explained above. The cookies are unique consumer identifiers, while the IP addresses are network site identifiers, both of which are stored to enable the ad database to deliver a targeted ad when the consumer visits a participating site that is to include such advertising.

Regarding the "subscriber" language of claims 1 and 22, the participating web site that displays the targeted advertising is taken to be a subscriber/subscriber site offering a targeted promotion. The website subscribes to and receives the services of the central ad serving system which serves the advertising to the subscribing website. Displaying a targeted advertisement for a good/service is taken to meet the creation and display of a promotion of goods/services "offered" by the subscriber site. Display of the ad provides the offering, regardless of what party/parties are also involved in any subsequent sale of the good/service.

Regarding claim 8, Gardenswartz et al teaches using cookies to track user's Internet browsing history. Gardenswartz et al also teaches tracking online purchases; this is taken to provide a history that includes association with such reviewed products (or services). Further, Gardenswartz et al also teaches to rely on the types on subject

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matter accessed/reviewed [col 2 lines 52-53], where the history of sites visited includes IP addresses corresponding to fly fishing for example.

Regarding claim 24, Gardenswartz et al and Roth et al do not limit the user's history to only pages visited or purchases made on sites where targeted advertising is provided by the system. It would have been obvious to one of ordinary skill at the time of the invention to have used any visited IP addresses or purchases made from any IP addresses as part of the history, including from sites that are "non-subscribers" or are not configured to receive the targeted advertising of the taught system(s). This would enable a wider range of visited sites to enrich and provide a true user history profile, thereby enriching the targeted advertising.

Claim 8 (alternatively) is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al in view of Travis et al (US2002/0010668). Travis et al teaches dynamically providing targeted ads to viewers of web sites. Travis et al teaches a database of user profiles/preferences that includes purchases made and products reviewed which is used during selection of a banner ad [para 21]. It would have been obvious to one of ordinary skill at the time of the invention to have used such stored preference information as products/services reviewed and products/services purchased to create a more accurate profile so that the system of Gardenswartz et al can deliver a more effective ad.

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(11) Response to Argument

Applicant argues that the rejection is flawed because Gardenswartz et al. discloses the online activity targeting in the Background of the Invention and offline activity targeting in the rest of the disclosure. Examiner disagrees. The examiner is properly relying on the background/online disclosure for what it teaches, which is equally available to one of ordinary skill as is the summary and detailed disclosure of Gardenswartz et al. The disclosure of online targeting is clear and one of ordinary skill would find it obvious to combine with Roth et al, regardless of other teachings of Gardenswartz et al. The combination in no way destroys the Gardenswartz et al reference.

Regarding the "subscriber" language of claims 1 and 22, the participating web site that displays the targeted advertising is taken to be a subscriber/subscriber site offering a targeted promotion. The website subscribes to and receives the services of the central ad serving system which serves the advertising to the subscribing website. Displaying a targeted advertisement for a good/service is taken to meet the creation and display of a promotion of goods/services "offered" by the subscriber site. Display of the ad provides the offering, regardless of what party/parties are also involved in any subsequent sale of the good/service. Examiner's current and previous stance on requirements for the single, broad term "subscriber" appear to be less an issue than the interpretation of "promotion of goods/services offered by a [subscriber/entity]."

Applicant argues that the examiner has not addressed the subscriber database (claim 3), nor the inclusion of the subscriber site in such a database (claim 4). As stated

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previously in the final rejection, "[T]he centralized system includes database storage of ads as well as storage of information regarding the subscribing sites [col 2 lines 1-5].

Depending on the customer visiting, the characteristics of the subscribing site and other information, an ad is selected to be displayed to the user [col 2 lines 20-41]."

Applicant argues that the examiner has not addressed the receipt of consumer activity information upon a consumer visit to a network site (claim 10). The entire previous final rejection sets forth a combination for a centralized system (apparatus) where a user visiting a subscribing/participating site receives a targeted ad based upon the received/retrieved user's surfing history.

Applicant argues that the examiner has not addressed the non-subscriber activity information. As stated previously in the final rejection, "[r]egarding claim 24, Gardenswartz et al and Roth et al do not limit the user's history to only pages visited or purchases made on sites where targeted advertising is provided by the system. It would have been obvious to one of ordinary skill at the time of the invention to have used any visited IP addresses or purchases made from any IP addresses as part of the history, including from sites that are "non-subscribers" or are not configured to receive the targeted advertising of the taught system(s). This would enable a wider range of visited sites to enrich and provide a true user history profile, thereby enriching the targeted advertising."

Applicant appears to argue that claim 8 is separately patentable from base claim 1, yet claim 8 appears to stand or fall together with claim 1. Nonetheless, the argued "irrelevance" is not convincing. Travis teaches targeting ads to web site visitors by

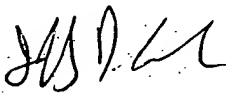
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using purchases made and products reviewed – highly “relevant” to applicant’s field of endeavor and to Gardenswartz et al, such that the 103 combination is quite reasonable.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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jdc
April 30, 2004

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